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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
MCMAHON, MARGUERITE J	
ART UNIT	**PAPER NUMBER**
3747	

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/673,221	OHSUGA ET AL.	
	Examiner	Art Unit	
	Marguerite J. McMahon	3747	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *28-36,38-40 and 43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *28-36,38-40 and 43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 28, 29, 34-36, 38-40, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hitomi et al (5,063,899). Note a suction device for an internal combustion engine comprising a collector (after throttle 9) into which air flows through a throttle valve 9, which is (inherently) located in a throttle housing, and individual suction pipes 4a, 4b, 4c for distributing the air to respective cylinders 2 of the internal combustion engine from the collector, wherein said collector and said individual suction pipes are (inherently) formed as an assembly body (in order to function), and wherein the throttle valve 9 is comprised of an electronically controlled throttle valve which is driven by a motor 9b which is controlled by a control module 13, said motor for driving said throttle valve being (inherently) located in a housing. Hitomi et al show everything except explicitly disclosing that the motor is located in a housing in said assembly body and the air cleaner portion being formed on an upper portion of the assembly body and the motor for driving the throttle valve being located in a housing on the module.

It would have been obvious to one having ordinary skill in the art to locate the motor in a housing in said assembly body in order to consolidate the device, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In*

re Japikse, 86 USPQ 70. Indeed, the term "assembly body" is very broad and could almost be construed to read as a 102 on Hitomi et al. However, in the light of the specification and drawings, the examiner is interpreting the claims as indicating that the motor is directly attached to or housed in one of the elements comprising the intake device. With respect to claim 43, note that the motor also comprises a second motor 8b, which drives a second set of throttle valves 8.

Note also that the Figures provided by Hitomi et al are schematic and therefore do not show all the relative locations of the various elements clearly. However, it would have been obvious to one of ordinary skill in the art to locate the air cleaner portion on an upper portion of the assembly body, as this is conventional.

Claims 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shillington (5,005,532) in view of Hitomi et al (5,063,899). Shillington shows everything except the throttle valve being electronically controlled by a motor. Hitomi et al teach that it is old in the art to utilize a motor 9b, 8b to control the throttle valves 9 and 8, the motor being electronically controlled by control module 13. It would have been obvious to one of ordinary skill in the art to modify Shillington by employing a motor controlled electronically by a control module to control the throttle valve 54 (see Figure 1), in order to provide improved control over the air flow to the cylinders.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 28 and 29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,701,881. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are basically claiming the same thing. The reference shows everything except the motor being located in a housing in said assembly body. It would have been obvious to one having ordinary skill in the art to locate the motor in a housing in said assembly body in order to consolidate the device, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Indeed, the term "assembly body" is very broad. However, in the light of the specification and drawings, the examiner is interpreting the claims as indicating that the motor is directly attached to or housed in one of the elements comprising the intake device.

Claims 38-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,701,881 in view of Hitomi et al (5,063,899). Patent No. 6,701,881 shows everything except a control unit, coupled to the motor by wiring and the motor being located in a housing in said assembly body. Hitomi et al teach that it is old in the art to employ a

control unit 13 coupled to the motor by wiring. It would have been obvious to one having ordinary skill in the art to modify 6,701,881 by employing a control unit coupled to the motor by wiring, in order to control the motor, and to locate the motor in a housing in said assembly body in order to consolidate the device, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Indeed, the term "assembly body" is very broad. However, in the light of the specification and drawings, the examiner is interpreting the claims as indicating that the motor is directly attached to or housed in one of the elements comprising the intake device.

Claims 30, 32, 34, and 35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,523,517. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are basically claiming the same thing. The reference shows everything except the motor being located in a housing in said assembly body. It would have been obvious to one having ordinary skill in the art to locate the motor in a housing in said assembly body in order to consolidate the device, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Indeed, the term "assembly body" is very broad. However, in the light of the specification and drawings, the examiner is interpreting the claims as indicating that the motor is directly attached to or housed in one of the elements comprising the intake device.

Response to Arguments

Applicant's arguments filed 5/2/05 have been fully considered but they are not persuasive. Applicant argues that the references do not show a motor which is attached to the throttle housing. While it is true that the references are silent as to exactly how the motor is mounted, the motor being mounted on the assembly body does not constitute a patentable distinction, as it would have been within the purview of one of ordinary skill in the art to locate the motor in a housing in the assembly body. Note that Applicant has broadened some of the claims by substituting "assembly body" for the term "one-piece suction module". This language is construed to read on Hitomi et al (5,063,899) since the term "assembly body" is interpreted as meaning that an assembly of parts are brought together to function as a unit.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marguerite J. McMahon whose telephone number is 703-308-1956. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yuen Henry can be reached on 703-308-1946. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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MARGUERITE MCMAHON
PRIMARY EXAMINER